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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,812	01/09/2006	Ana Maria Hernandez Maestre		1908

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EXAMINER

LEE, GILBERT Y

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3673

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,812	Applicant(s) HERNANDEZ MAESTRE, ANA MARIA	
	Examiner Gilbert Y. Lee	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Note that there are two sets of specification, claims, and abstract. The examiner is considering the specification and claims stamped "IAP15 Rec'd PCT/PTO 09 JAN 2006" and the abstract from the WIPO publication for the purposes of this examination.

Information Disclosure Statement

2. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining

compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Specification

3. The abstract of the disclosure is objected to because it exceeds the 150 word maximum. Correction is required. See MPEP § 608.01(b).
4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if

the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Specifically, the above section headings must be used in the specification.

The disclosure is objected to because of the following informalities: the "y" in lines 8 and 15 on page 5 should be changed to --and--; "showed" in line 14 on page 5 should be changed to --shown--; and a --,-- should be added between "seat a" in lines 17 and 23 on page 5.

Appropriate correction is required.

5. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

6. The claims are objected to because they are not compliant with 37 CFR § 1.75(i), i.e. "Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation."

7. Claim 1 is objected to because of the following informalities: the "." in line 15 must be removed. Appropriate correction is required.

8. Claim 3 is objected to because of the following informalities: the "are." in line 12 must be changed to --are-- and the "." in line 19 must be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 3, the phrase "Velcro type or similar" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "type or similar"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 2, the phrase "any other type" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "any other type"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent

protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989); as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation an elastic material, and the claim also recites "preferably latex" which is the narrower statement of the range/limitation.

Regarding claim 4, the phrase "or other types" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or other types"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 5, the phrase "other elements" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "other elements"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

10. Claims 4 and 5 recite the limitation "it" in line 2. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 6 recite the limitation "the bed" in line 4. There is insufficient antecedent basis for this limitation in the claim.

12. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

13. Claims 1 and 3 contain the trademark/trade name VELCRO. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe VELCRO and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1 and 3-6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bridley (US Patent No. 5,581,832).

Regarding claim 1, the Bridley reference discloses a mattress (Figs. 1-7) of independent and detachable parts, comprising:

a base (12);

a plurality of independent and detachable parts (e.g. 14 and 16) that are placed on said base (Figs. 1-7), said plurality of independent and detachable parts placed on said base being composed simultaneously by independent parts of different shapes, different sections, different heights and of different materials (Figs. 1-7) and each of these independent and detachable parts being separated by a distance from the detachable and independent part adjacent to it (Figs. 1-7);

auto adherent joining means (e.g. including 30, 32, 34, and 36) join in a detachable way said base with plurality of independent and detachable parts (Col. 4, Lines 1-17)

wherein

the placement of said independent and detachable parts over the base being free (Figs. 1-7), the placement of each independent and detachable part depending exclusively on the convenience of locating it in any given place according to the needs of the user's body (Col. 2, Lines 1-27), and without any further restriction except that the

portion of the base over which each detachable part is placed must be covered with said joining means (Figs. 1-7).

Regarding claim 3, the Bridley reference discloses the auto adherent joining means used to detachably join said base with said plurality of independent and detachable parts comprise:

a) a plurality of continuous or separated fabric auto adherent and detachable strips (e.g. 30 and 32) joined to the upper surface of said base and placed in a sufficient quantity to allow for placing said independent and detachable parts, no matter what their dimensions, sections and shapes are in whatever position of said upper surface of said base (Figs. 1-7); and

b) some auto adherent complementary fabric sheets (e.g. 34 and 36) to complete, one joined to said auto adherent fabric, said joining means, each of said complementary auto adherent fabric sheets being joined to the lower surface of the corresponding independent and detachable parts (Figs. 1-7) and each of the said sheets of auto adherent complementary fabric being the same in dimension as said lower surface of the independent and detachable part to which they are joined to (Figs. 1-7)

whereby, through the joining of said sheets of complementary and auto adherent fabric with said continuous sheet of auto adherent fabric or with said continuous or separate strips of auto adherent fabric, a detachable joining is established between said base and said plurality of independent and detachable parts which are placed over said base (Col. 4, Lines 1-17).

Regarding claim 4, the Bridley reference discloses that it can be provided with an outer cover (e.g. 40 and 50) that features side fasteners in all or some of the sides (Figs. 5-6). Note that the fasteners of the Bridley reference are **capable of** allowing changing of the independent parts.

Regarding claim 5, the Bridley reference discloses that it can be used by means of an adequate choice of shapes and dimensions of its components, as a cushion, a seat and a headrest including those of vehicles, an armrest, a footrest, a pillow and other elements for the daily rest of an adult or child's body (Col. 2, Lines 1-5 and Figs. 1-7).

Regarding claim 6, the Bridley reference discloses that by placing independent and detachable parts of greater height than the others in the areas of the edge of the mattress a mattress that avoids children falling off the bed is formed (Figs. 1-7). Note that because the Bridley reference is intended to be used by a user in a fetal position, the independent parts would be **capable of** preventing children from falling off a bed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bridley.

Regarding claim 2, the Bridley reference discloses the independent and detachable parts being of a shape selected from prismatic, cylindrical, conical or pyramidal trunk of any other type that can deform elastically when submitted to a load perpendicular or slightly inclined with respect to the upper surface of the base of the mattress (Figs. 1-7); the height of said independent and detachable parts being variable according to the needs of the user or patient (note that the parts will vary in height depending on how the user is positioned on the parts).

However, the Bridley reference fails to explicitly disclose the material of the independent parts. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the Bridley reference with latex since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of mechanical expedience and in order to provide a material with the desired resilience.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilbert Y. Lee whose telephone number is 571-272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on (571)272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/563,812
Art Unit: 3673

Page 12

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GL
December 17, 2007

A handwritten signature in black ink, appearing to read "Patricia Engle", with a stylized flourish at the end.

Patricia Engle
Supervisory Examiner
Tech. Center 3600